

### REMARKS

This Amendment is in response to the Final Office Action mailed November 1, 2005. With this Amendment claims 1, 12, and 19-31 are amended. Further, the Applicant requests entry of the Amendments presented on January 3, 2006. Reconsideration and withdrawal of the rejection are respectfully requested in view of the following remarks.

In item 3 of the Office Action the Examiner rejected 1-31 under 35 USC§103(a) as being unpatentable over Burrows (6021409) in view of Sarukkai et al. (5819220). The Examiner asserted that Burrows teaches all of the elements of the claims. However, the Examiner asserted that Burrows does not explicitly teach the use of the word techniques in a speech related application. The Examiner then asserted that Sarukkai teaches using word list techniques in a web based speech applications. Then the Examiner asserted that it would have been obvious to one of ordinary skill in the art of internet portals to adapt the teachings of Burrows into speech related web applications because it would advantageously tailor the speech enabled sites to specific vocabularies. The applicant has reviewed the references and must respectfully disagree.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art (to which the invention is directed), to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. See In re Vaeck, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. §2143.

First of all the Applicant reasserts the argument 5 made in the previous papers, that the Burrows reference is inapplicable to the present claims. The claims of the present invention as amended are directed to a compressed speech lexicon for use in speech recognition and synthesis. However, it should be noted that Burrows only discloses an indexing process for indexing web pages, and not a speech lexicon for speech applications. It is clear from the disclosure of the Burrows document that there is no lexicon used or created from the web pages and that an index of words in a web page is not a speech lexicon for a speech application. Further, the Burrows reference is totally inapplicable for use in a speech application. Thus, the Burrows reference and

the present invention are completely unrelated, and patentably distinct from each other. Therefore, the applicant asserts that one of ordinary skill in the art of speech applications would not look or consider a web indexing procedure to be relevant to a speech application or for generating a speech lexicon, of any sort for a speech application.

Second the Examiner states that one of ordinary skill in speech application would look to the Sarukkai reference to account for the shortcomings of the Burrows reference. The Sarukkai reference is directed to a computer system for user provided speech actuation of access to stored information. A speech recognition processor operating on the computer system recognizes words based on the input speech utterances of the user in accordance with a set of language/acoustic model and speech recognition search parameters. Software running on the CPU scans a document accessed by a web browser to form a web triggered word set from a selected subset of information in the document. The language/acoustic model and speech recognition search parameters are modified dynamically using the web triggered word set, and used by the speech recognition processor for generating a word string for input to the browser to initiate a change in the information accessed. Sarukkai, describes the basics of speech recognition, and a method for dealing with out of context words. The Sarukkai reference relates to speech recognition and web applications, and has nothing whatsoever to do with generating a compressed speech lexicon for use in a speech application. Therefore, the applicant asserts that the Sarukkai reference is also inapplicable to the present set of claims.

The Examiner has apparently determined that the present invention is directed towards speech recognition in internet portals. As the primary reference the Examiner has cited a reference directed to a "Method for Parsing, Indexing and Searching World Wide Web Pages". The Examiner has not provided any indication as to why one of ordinary skill in the speech application/recognition art would consider this reference relevant to generating a compressed lexicon for use in a speech application. Therefore, the applicant asserts that the Examiner has not made a *prima facie* case of obviousness. Thus, the applicant asserts that the obviousness rejection has been overcome.

The Applicant further submits that claims 1-31 are non-obvious in view of the cited references because there is no motivation or suggestion to combine them. The Federal Circuit has

held that rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use a claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention, which would be "an illogical and inappropriate process by which to determine patentability." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (citing *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ.2d 1551, 1554 (Fed. Cir. 1996)). Even seemingly simple changes require a finding of a suggestion in the prior art to make the modification to avoid the improper use of hindsight.

Applicant simply believes that the standard used for combining references is incorrect and does not follow the current standard as set forth clearly by the Federal Circuit in *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Court of Lee held that a factual inquiry on whether to combine references must be based on objective evidence of record, which has been reinforced in a number of decisions. *In re Lee* at 1433, citing *McGinley v. Franklin Sports, Inc.*, 60 USPQ 2d 1001, 1008 (Fed Cir. 2001) and *Brown & Williamson Tobacco Corp. v. Phillip Morris Inc.*, 56 USPQ 2d 1456, 1459 (Fed. Cir. 2000). Therefore, the Applicant asserts that there is no motivation to combine the references.

Further, in the previous paper the Applicant provided a detailed analysis of the Burrows reference as it compared to the claims of the present application. The applicant pointed out a number of differences or deficiencies in the Burrows reference as applied to the present claims. The Applicant reasserts these statements. The addition of the Sarukkai reference does not remedy any of these deficiencies. Therefore, the combination of the Burrows and Sarukkai references (if applicable) does not render the claims obvious. Thus for this reason, as well, the Applicant asserts that the obviousness rejection has also been overcome.

In item 4 of the Office Action the Examiner indicated that although the claims are interpreted in light of the specification, limitations are not read into the claims. The Examiner is correct. However, the Applicant is also entitled to be their own lexicographer defining the meaning of a word or words. It is entirely proper to use the Specification to interpret what the Applicant meant by a word or phrase in the claim. See Dupont DeNemours and Co. vs. Phillips Petroleum Co., 849 F.2d 1430, 7 U.S.P.Q. 2d 1229, 1131, *cert. denied* 488 U.S. 986 (1988). Therefore, the Applicant is respectfully requesting the Examiner give the claims the appropriate

meanings as defined in the specification, and as argued in the previous paper.

The applicant has argued on many occasions that the preamble limitation of a compressed speech lexicon for use in a speech application is a patentable limitation. The Federal Circuit has held that, the preamble is limiting “if it recites essential structure that is important to the invention or *necessary to give meaning to the claim*.” See *Bicon v. Straumann* (Fed. Cir. 2006, 05–1168, at 12, March 20, 2006) citing *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1305-06 (Fed. Cir. 2005), cert. denied, 74 U.S.L.W. 3421 (U.S. Jan. 23, 2006); *SanDisk Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278, 1284 n.2 (Fed. Cir. 2005), cert. denied, 126 S. Ct. 829 (2005) emphasis added. This is especially true in this case. The preamble is necessary to properly limit that which the applicant is claiming. In particular there are different types of lexicons that are used in and for different applications. Depending on the use of the lexicon different information is stored as word-dependent data, and that data is specific to the lexicon’s use.

Speech applications differ from other applications that make use of lexicons. Vastly more and/or different information is required about a word in a lexicon for speech applications than is required for a word used in a lexicon for simple word searching or internet retrieval. Word dependent data in this context (speech applications) is described, for example, on page 14 line 23 of the specification as pronunciation. Pronunciation is a key component of word dependent data in speech recognition, and thus one of ordinary skill would readily recognize that limitation of “for use in a speech application” in the preamble properly frames and limits what is or is not a component of the word-dependent data. The *Burrows* reference does not teach or suggest a use in a speech application and therefore, any “word dependent data” references therein are not applicable to speech applications and further could not be used in such cases as the necessary data for use in speech applications is missing. Therefore, the applicant respectfully submits that the limitations of the preamble properly frame the claims and therefore distinguish the claims over the prior art of record.


In conclusion, it is believed that neither *Burrows* nor *Sarukkai* taken singly or in combination disclose, teach or suggest the elements of any of claims 1-31 as amended. Specifically, it is asserted that *Burrows* does not disclose a speech lexicon for speech applications as is commonly understood in the art, or word-dependent data as defined in the specification. Therefore, it is asserted that claims 1-31 are allowable over *Burrows* in view of *Sarukkai*.

Reconsideration and allowance are respectfully requested.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By:   
Nathan M. Rau, Reg. No. 45,466  
Suite 1400  
900 Second Avenue South  
Minneapolis, Minnesota 55402-3244  
Phone: (612) 334-3222 Fax: (612) 334-3312

NMR/mek